

Serial No. 09/812,846

REMARKS

In the Office Action the Examiner noted that claims 1-22 are pending in the application. The Examiner rejected claims 1-21, and withdrew claim 22 from consideration. By this Amendment, claims 1-4, 7-10, and 13-19 have been amended, and claim 22 has been cancelled without prejudice or disclaimer. No new matter has been presented. Thus, claims 1-21 are pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Entry of Amendment Under 37 C.F.R. §1.116

The Applicant requests entry of this Rule 116 Response because: the amendments were not earlier presented because the Applicant believed in good faith that the cited references did not disclose the present invention as previously claimed; the amendments of claims 1-4, 7-10, and 13-19 should not entail any further search by the Examiner since no new features are being added and no new issues are being raised; and the amendments do not significantly alter the scope of the claim, and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Claim Rejections Under 35 USC §112

On pages 3-4 of the Office Action the Examiner rejected claims 1, 3, 7, 9, 13, 16, and 18 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner stated that it is not clear what the Applicant means by "generating a data part from an original print data." The Examiner cited, as a source for the confusion, line 35 of page 12 through line 4 of page 13 of the specification, and further stated that the Examiner assumed that

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"generating a data part from an original print data" means the process of printing a document or a file or an image.

By this Amendment, claims 1, 3, 7, 9, 13, 16, and 18 have been amended, and no longer include the language cited by the Examiner. For example, the data part is recited in claim 1 of the present application is generated by analyzing an input print job formed by a set of commands, as opposed to the printing of a document discussed regarding the Examiner's assumption. Support for this amendment is provided at least in the discussion (of one possible embodiment) on page 11, line 30 through page 14, line 28 of the specification, as well as in Figures 2 and 3.

As such, the Applicant further respectfully submits that claims 1, 3, 7, 9, 13, 16, and 18 are proper according to 35 U.S.C. §112, second paragraph, and respectfully requests the withdrawal of the Examiner's rejections of these claims.

Restriction Of Claim 22

On pages 4-5 of the Office Action the Examiner withdrew claim 22 from consideration as being directed to a non-elected invention.

By this Amendment, claim 22 is cancelled without prejudice or disclaimer.

Claim Rejections Under 35 USC §102

On pages 5-9 of the Office Action the Examiner rejected claims 1-21 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,489,954, issued to Powlette (hereinafter referred to as "Powlette"). The Applicants respectfully traverse the Examiner's rejections of these claims.

Independent claim 1, as amended, recites a processing apparatus for generating an executable file, comprising "a data generating part generating a data part by analyzing an input print job formed by a set of commands." The Applicant respectfully submits that at least this feature of claim 1 is not disclosed or suggested by Powlette.

Powlette discloses transferring file data from a local computing system to a remote server by storing an applet window data as an image file (e.g., a GIF or JPEB formatted file) and transferring the image file to the remote server. For example, as shown in Figures 3A and 3B, an applet window image data (325) is derived from an initial data file (165) to permit a user to

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interact with the image presented (see also Column 3, Line 62, through Column 4, Line 4; and Column 11, Lines 1-24). In other words, a Java applet program loaded initially from a remote server is configured to receive additional user annotations for data displayed in an already opened applet window located at the user's client system. To increase the usefulness and flexibility of such a program, the user is permitted to preserve/capture, during an interactive session, the modified applet window containing any such input or modifications to the applet window data. Because the updated applet window data cannot be written to the user's client system due to security restrictions, Powlette instead causes such modified window data to be converted to a standard compressed graphics file format such as the GIF for in image file, for example, and then uploaded to the remote server.

This is in direct contrast to claim 1 of the present application, which enables use of an executable file among different apparatuses by generating a data part by analyzing an input print job formed by a set of commands.

In the Examiner's Response To Arguments, the Examiner stated that Powlette discloses that the modified data file 166 is then displayed in a graphics image format in a separate window 350 where it can be printed to output device 135 (Column 11, Lines 25-31, and Figure 1). The Examiner went on to state that printing original captured image implies generating print data to be printed.

The Applicant respectfully submits that even if, arguendo, "printing original captured image implies generating print data to be printed" in Powlette, this does not anticipate at least the feature of "generating a data part by analyzing an input print job formed by a set of commands." To wit, the Examiner has acknowledged that the cited section of Powlette discloses printing an original capture image. But this is not related to the language recited in claim 1. As previously discussed in this Amendment, a data part is generated by analyzing an input print job formed by a set of commands, and that generated data part is then included in an executable file which is generated to also include an updating part which updates contents of the executable file using data modified by the developed data processing part. In other words, the original input print job is not printed, but rather is analyzed to generate a data part which will then be processed and modified so that it may be used by various apparatuses. This is in direct contrast to Powlette, which merely prints a modified data file that is displayed in a graphics image format, and does not disclose or suggest generating a data part by analyzing an input print job formed by a set of commands. This is apparent from Column 11, Lines 25-31 of Powlette, which describes displaying a returned modified data file 166 in a graphics image

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format in a separate window where it can be printed. Therefore, it is apparent that this "print data" of Powlette is not used to generate a data part to be further processed and modified, rather it is simply printed in a conventional manner.

Therefore, Powlette does not disclose or suggest at least the feature of "generating a data part by analyzing an input print job formed by a set of commands." Accordingly, Powlette does not disclose every element of the Applicant's claim 1. In order for a reference to anticipate a claim, the reference must teach each and every element of the claim (MPEP §2131). Therefore, since Powlette does not disclose the features recited in independent claim 1, as stated above, it is respectfully submitted that claim 1 patentably distinguishes over Powlette, and withdrawal of the §102(e) rejection is earnestly and respectfully solicited.

Claim 2 depends from claim 1 and includes all of the features of that claim plus additional features which are not disclosed or suggested by Powlette. Therefore, it is respectfully submitted that claim 2 also patentably distinguishes over Powlette.

Claims 3, 7, 9, 13, 16, and 18 all similarly recite features including generating a data part by analyzing an input print job formed by a set of commands, the generated data part then being further processed and modified. As discussed above in regard to claim 1, Powlette does not disclose or suggest generating a data part by analyzing an input print job formed by a set of commands, nor does Powlette disclose or suggest then further processing and modifying the data part. Therefore, claims 3, 7, 9, 13, 16, and 18 also patentably distinguish over Powlette.

Claims 4-6 depend from claim 3, claim 8 depends from claim 7, claims 10-12 depend from claim 9, claims 14-15, depend from claim 13, claim 17 depends from claim 16, and claims 19-21 depend from claim 18. These dependent claims include all of the features of their respective independent claims plus additional features which are not disclosed or suggested by Powlette. Therefore, it is respectfully submitted that claims 4-6, 8, 10-12, 14-15, 17, and 19-21 also patentably distinguish over Powlette.

Summary

In accordance with the foregoing, claims 1-4, 7-10, and 13-19 have been amended, and claim 22 has been cancelled without prejudice or disclaimer. No new matter has been presented. Thus, claims 1-21 are pending and under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously

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solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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